

REMARKS

1. Rejection Under 35 U.S.C. 102 and 103

Claims 1-20, 24, and 25 have been rejected under 35 U.S.C. 102(b/e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morgan et al. (3,994,771), Bredendick et al. (5,861,081), Tseng (5,652,035), Atkins (2,130,375), Milliken (2,113,431 or 2,281,945) or Bletzinger et al. (2,950,223). Claims 1-25 have been further rejected under 35 U.S.C. 102(b/e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamps et al. (6,203,663), Ayers (5,628,876), Van Phan (5,277,761) or Trokhan et al. (5,503,715).

Examiner recognizes that "[t]he references (understood to be Morgan, Bredendick, Tseng, Atkins, Milliken, and Bletzinger) are silent as to the property of being expandable in the Z-direction or thickness upon application of plastic extension of the sheet." Nevertheless, the Examiner makes a conclusory statement that "in as much as the tissue paper has the slit or perforations as disclosed in the instant specification, it is inherent that the aforementioned prior art have the claimed expandable thickness. Thus, the prior art anticipates or at least obviously show the claimed in invention." *Office Action*, page 2. The Examiner makes a similar argument with respect to Kamps et al., Ayers, Van Phan and Trokhan et al. references, stating that "the prior art inherently have the claimed Z-direction or thickness expansion property. . . . Thus, the prior art anticipates, or at the least, obviously show the claimed invention." *Office Action*, page 3.

These rejections are respectfully traversed.

First, the undersigned would like to highlight key features of the present invention. The tissue paper of the present invention comprises a substrate that can be activated by a consumer. *Specification at 4:8-10*. Upon activation, the thickness of the paper increases in the proportion greater than the corresponding increase in elongation. *Specification at 5:27-28, 17:6-13, Claim 1*. For example, as the consumer applies tensile forces to the sheet of paper (i.e., pulls the paper apart) the substrate increases its overall thickness such that a percentage increase in thickness is greater than the percentage elongation of the substrate. In another aspect, the present invention comprises a plastically activatable tissue paper, wherein a thickness upon activation is at least four times of a thickness prior to activation. In still another aspect, the present invention comprises a multi-ply tissue

product having a thickness of at least 2 millimeters and a density of less than 0.01 gram per cubic centimeter.

These unique qualities of the tissue paper are neither disclosed nor suggested in either of the cited references, alone or in combination, the fact the Examiner seems to recognize. Nevertheless, the Examiner relies on anticipatory inherency or, in the alternative, on obviousness to reject the claims.

The Examiner's reliance on both inherency and obviousness in conjunction seems ambiguous "as to the precise basis upon which the examiner has bottomed the rejection" and therefore improper. *Ex parte Schricker, infra*. As the Board's recent decision states, "inherency and obviousness are somewhat like oil and water - they do not mix well." *Ex parte Schricker*, No. 1996-2414, Decided June 7, 2000, Released September 21, 2000. In *Ex parte Schricker*, The Board specifically stated that "when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory." (citation is omitted). Similarly, The Federal Circuit instructs that when the Examiner asserts that there is an explicit or implicit teaching or suggestion in the prior art, the Examiner must indicate where such a teaching or suggestion appears in the prior art. *In re Yates*, 663 F.2d 1054, 1057; 211 USPQ 1149, 1151 (CCPA 1981).

As far as the 35 USC 102 rejection is concerned, neither of the cited prior art references teaches or suggests a requirement that a percentage increase in thickness is greater than a percentage increase of elongation in either length direction or width direction of a tissue paper. If the Examiner still believes that the cited prior art "inherently" have the claimed requirement, the Examiner is respectfully requested to state how he reached such a conclusion, i. e., "to point to the "page and line" of the prior art which justifies an inherency theory." *Ex parte Schricker, supra*.

With respect to the 35 USC 103 obviousness rejection, it is respectfully submitted that the Examiner did not establish a *prima facie* case of obviousness. MPEP instructs that one of the "basic criteria" of establishing the *prima facie* case of obviousness is that "the prior art reference . . . must teach or suggest all the claim limitations." *MPEP* 706.02(j), citing *In re Vaek*, 947 F2d. 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the Examiner did not indicate any suggestion or motivation in the cited prior art that a substrate can increase its overall thickness upon activation such that a percentage increase in thickness is greater than the percentage elongation of the substrate. Nor did the Examiner indicate any

suggestion or motivation in the cited art of a multi-ply tissue product having a thickness of at least 2 millimeters and a density of less than 0.01 gram per cubic centimeter, or a tissue paper wherein a ratio of a second thickness (upon activation) to a first thickness (prior to activation) is at least 4.

By the present amendment, Claims 21-23 have been cancelled, without prejudice. Claims 15 and 24 have been amended to require that the tissue paper comprises the substrate according to Claim 1. A minor typographical error in Claim 15 and a grammatical error in Claim 24 were corrected.

2. Provisional Obviousness-Type Double Patenting Rejection

Claims 1-25 have been rejected under judicially created Doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of co-pending Application No. 09/705,616. It is respectfully submitted that Application No. 09/705,616 was abandoned on September 20, 2001. Therefore, the obviousness-type double patenting rejection is believed to be moot.

3. Conclusion

For the reasons stated above, the 35 USC 102/103 rejections and the obviousness-type double patenting rejection should be withdrawn. The Examiner is respectfully requested to reconsider the claims, as amended, and in view of the foregoing argument.

For the Examiner's convenience, the entire set of claims as amended is attached hereto.

Respectfully submitted,



Vladimir Vitenberg
Attorney for Applicant(s)
Registration No. 42,204
(513) 634-2648

Date: 3/20/02

Customer No. 27752

VERSION WITH MARKINGS TO SHOW CHANGES MADE

15. (Amended) A generally planar tissue paper comprising at least two plies joined in face-to-face relationship, wherein at least one of the plies comprises the substrate according to Claim 1, said tissue paper having a length direction and a width direction defining an XY plane [in] and a Z-direction perpendicular thereto, said tissue paper having a thickness in said Z-direction, said tissue paper being plastically extensible in at least one of said length direction and said width direction, whereby plastic extension of said tissue paper causes an increase in said thickness of said tissue paper.

24. (Amended) A tissue paper comprising the substrate according to Claim1, and having a basis weight of 10 to 140 grams per square meter, said tissue paper having a plurality of lines of weakness therein, said tissue paper being activatable in a first direction, whereby opposed tensile forces cause[s] strain in said tissue paper parallel to said direction of opposed tensile forces, said thickness of said tissue paper increasing in response to said strain.